

ESTTA Tracking number: **ESTTA681857**

Filing date: **07/06/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	MACRON S.P.A.
Granted to Date of previous extension	07/22/2015
Address	Via Brodolini, 5 CRESPPELLANO (BO), 40056 ITALY

Attorney information	Nicholas D. Wells Kirtan McConkie 60 E. South Temple, Suite 1800 Salt Lake City, UT 84111 UNITED STATES nwells@kmclaw.com Phone:801-328-3600
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Applicant Information

Application No	86427711	Publication date	03/24/2015
Opposition Filing Date	07/06/2015	Opposition Period Ends	07/22/2015
Applicant	Laura Preskin 250 Ferndale Road Scarsdale, NY 10583 UNITED STATES		

Goods/Services Affected by Opposition


Class 025. First Use: 2012/12/09 First Use In Commerce: 2012/12/09
All goods and services in the class are opposed, namely: Athletic pants; Athletic shirts; Athletic shorts; Athletic skirts; Athletic tops and bottoms for tennis; Tennis wear; Women's athletic tops with built-in bras

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Void for false or incorrect ownership under Section 1(a)(1) of the Lanham Act

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3233563	Application Date	09/09/2005
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Registration Date	04/24/2007	Foreign Priority Date	04/14/2005
Word Mark	NONE		
Design Mark			
Description of Mark	The trademark consists of the fancy representation of the figure of a bust inside a circle.		
Goods/Services	<p>Class 018. First use: First Use: 0 First Use In Commerce: 0 Bags for sport and athletic use, knapsacks, [waist bags, school bags, hand-bags,suitcases,] carry-on bags, travelling bags, [purses, pocket wallets, briefcases; umbrellas]</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0 CLOTHING FOR SPORTS AND LEISURE, NAMELY, SHORTS, PANTS, [TROUSERS, BLUE JEANS; T-SHIRTS, TANK TOPS,] SWEATSHIRTS, TRAINING SUITS, WARM-UP SUITS, ATHLETIC UNIFORMS, JACKETS, RAIN PROOF JACKETS, PARKAS, [COATS, BLOUSES, JERSEYS, SKIRTS,] SWEATERS, [CARDIGANS, DRESSES,] UNDERWEAR, SOCKS, [STOCKINGS, TIGHTS,] WRISTBANDS, [SWEAT BANDS, SHOULDER AND LEG PADS FOR CLOTHING, BATHING SUITS, BATH ROBES, BICYCLING CLOVES, MOTORCYCLE GLOVES, RIDINGGLOVES, SKI GLOVES AND SNOWBOARD GLOVES, HATS,] CAPS, FOOTWEAR AND SPORTS FOOTWEAR, NAMELY, [ATHLETIC SHOES,] BASEBALL SHOES, [BOWLING SHOES, CYCLING SHOES, DECK SHOES, FOOTBALL SHOES, GOLF SHOES, GYMNASTIC SHOES, HANDBALL SHOES, HOCKEY SHOES, RUGBY SHOES, RUNNING SHOES, SOCCER SHOES, TENNIS SHOES,] TRACK AND FIELD SHOES[, TRAINING SHOES AND VOLLEYBALL SHOES]</p> <p>Class 028. First use: First Use: 0 First Use In Commerce: 0 BALLS FOR GAMES, namely, [BASKETBALLS,]SOCCER BALLS, FOOTBALLS, [VOLLEYBALLS,]HANDBALLS, BASEBALLS; KNEE, ANKLE AND ELBOW SUPPORTS FOR ATHLETIC USE; GOALKEEPERS GLOVES, [BOXING GLOWS, GOLF GLOVES,]BASEBALL GLOVES; SHIN GUARDS FOR ATHLETIC USE</p>		

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	Laura Preskin--TTAB Opposition.pdf(20181 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Nicholas Wells/
Name	Nicholas D. Wells
Date	07/06/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Mark: Circle design
Serial No.: 86427711
Published: March 24, 2015

MACRON S.P.A.		
	Opposer,	
v.		Opposition No. _____
Laura Preskin		
	Applicant	

NOTICE OF OPPOSITION

In the matter of trademark application Serial No. 86427711 (the “Application”) for Applicant’s Circle design trademark for “ Athletic pants; Athletic shirts; Athletic shorts; Athletic skirts; Athletic tops and bottoms for tennis; Tennis wear; Women's athletic tops with built-in bras” (“Applicant’s Goods”) in International Class 025, filed October 18, 2014 and published in the Official Gazette on March 24, 2015, Opposer MACRON S.P.A. ("Opposer"), a joint stock company registered in Italy and having an address at Via Brodolini, 5 CRESPELLANO (BO) ITALY 40056, believes it will be damaged by registration of the mark shown in the above-identified Application and hereby opposes the same.

The grounds for the opposition are as follows:

1. Opposer is a joint stock company organized under the laws of Italy having a place of business at Via Brodolini, 5 CREPELLANO (BO) ITALY 40056.
2. Opposer is the owner of U.S. trademark registration number 3233563 filed September 9, 2005 with a priority date of April 14, 2005 and registered April 24, 2007 for a Design (“Opposer’s Mark”) for (as currently amended) “Bags for sport and athletic use, knapsacks, carry-on bags, travelling bags” in Class 18; “CLOTHING FOR SPORTS AND LEISURE, NAMELY, SHORTS, PANTS, SWEATSHIRTS, TRAINING SUITS, WARM-UP SUITS, ATHLETIC UNIFORMS, JACKETS, RAIN PROOF JACKETS, PARKAS, SWEATERS, UNDERWEAR, SOCKS, WRISTBANDS, CAPS, FOOTWEAR AND SPORTS FOOTWEAR, NAMELY, BASEBALL SHOES, TRACK AND FIELD SHOES” in Class 25; and “BALLS FOR GAMES, namely, SOCCER BALLS, FOOTBALLS, HANDBALLS, BASEBALLS; KNEE, ANKLE AND ELBOW SUPPORTS FOR ATHLETIC USE; GOALKEEPERS GLOVES, BASEBALL GLOVES; SHIN GUARDS FOR ATHLETIC USE” in Class 28.
3. Opposer is a leading manufacturer of sporting apparel and accessories and provides products for use in soccer, football, handball, rugby, volleyball, running, and baseball, among other uses.
4. The filing date of Opposer’s registration 3233563 precedes the filing date of the opposed Application.
5. Opposer’s registration is valid, subsisting, and enforceable.
6. Opposer has expended significant resources in developing, advertising, and promoting its athletic products in the United States and throughout the world.

- Through such advertising and promotion, Opposer has developed valuable goodwill in Opposer's Mark. As such, Opposer's Mark is closely associated with Opposer in the minds of consumers and Opposer's Mark serves as a strong source identifier for the goods provided by Opposer.
7. On information and belief, Applicant Laura Preskin is an individual citizen of the United States residing in New York.

LIKELIHOOD OF CONFUSION

Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d)

8. Opposer re-alleges the allegations in Paragraphs 1 through 7 of this Notice of Opposition.
9. The circle design that Applicant seeks to register so resembles Opposer's Mark in appearance and commercial impression that the use and registration thereof is likely to cause confusion, mistake, and deception as to the source or origin of Applicant's Goods in violation of Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d), and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's Mark.
10. The use of Opposer's Mark by Opposer predates the filing date of the Application and any alleged first date of use in commerce of Applicant's circle design mark; consequently there is no question of priority of rights, as such priority clearly belongs to Opposer.
11. The opposed circle design mark and Opposer's Mark both consist of a circle having a reversed Y shape with a smaller circle above it.

12. The opposed circle design mark and Opposer's Mark can both reasonably be considered to represent a stylized figure of a person with arms raised above the head.
13. Applicant's Goods are identical to or so closely related to the goods offered by Opposer in connection with Opposer's Mark that the public is likely to be confused, deceived, and to assume erroneously that Applicant's Goods are those of Opposer or that Applicant is in some way connected with, licensed or sponsored by, or affiliated with Opposer, all to the irreparable damage of Opposer.
14. Likelihood of confusion is enhanced by the fact that Opposer's Mark is strong, famous, well-known, and entitled to a broad scope of protection.
15. Applicant is not affiliated or connected with Opposer and has not been endorsed or sponsored by Opposer nor has Opposer approved any of Applicant's Goods to be sold by Applicant under its alleged trademark.
16. Applicant has never obtained permission from Opposer to use Applicant's alleged mark nor has Opposer approved any of Applicant's Goods to be offered under Applicant's alleged mark.

VOID FOR FALSE OWNERSHIP

Section 1(a)(1) of the Lanham Act, 15 U.S.C. Section 1051(a)

17. Opposer re-alleges the allegations contained in Paragraphs 1 through 16 of this Notice of Opposition.
18. Upon information and belief, Applicant erroneously named the wrong owner of the mark in the Application filed on October 18, 2014.

19. Upon information and belief, Applicant Laura Preskin operates a business under the name Yaffa Activewear, and that business is the proper owner of the opposed circle design mark.
20. Applicant filed the Application as an individual even though sales of goods in connection with the opposed circle design mark are made through and by the Yaffa Activewear business.
21. Because an application that is not filed by its proper owner is void, the Application is void under Section 1(a)(1) of the Lanham Act.

FALSE SUGGESTION OF A CONNECTION

Section 2(a) of the Lanham Act, 15 U.S.C. Section 1052(a)

22. Opposer re-alleges the allegations contained in Paragraphs 1 through 21 of this Notice of Opposition.
23. Applicant's circle design mark is identical to or a close approximation of Opposer's Mark.
24. Opposer used Opposer's Mark in commerce within the United States long prior to the October 18, 2014 filing date of the Application.
25. Due to Opposer's extensive advertising, marketing and sales in the United States, consumers are likely to recognize that Opposer's Mark points uniquely and unmistakably to Opposer, given the fame and renown of Opposer.
26. Opposer is not connected with or affiliated with Applicant, Applicant's activities, or Applicant's circle design mark.
27. Opposer's Mark, and Opposer's name and identity are so famous and renowned that consumers would presume a connection between Applicant and Opposer

when they encounter Applicant's circle design mark as used on the goods set forth in the opposed Application.

28. Thus, Applicant's circle design mark falsely suggest a connection with Opposer and Opposer's Mark, in violation of Lanham Act § 2(a), and is not entitled to registration.

DILUTION

Section 43(c) of the Lanham Act

29. Opposer re-alleges the allegations contained in Paragraphs 1 through 28 of this Notice of Opposition.

30. As a result of the use and promotion of Opposer's Mark for a period of years for Opposer's goods identified above, Opposer's Mark has acquired significant goodwill and has become famous prior to Applicant's first use of its mark and the filing date of its application. Opposer's Mark is a famous mark within the meaning of Section 43(c) of the Lanham Act.

31. Registration of the confusingly similar circle design mark by Applicant will lessen the capacity of Opposer's Mark to identify and distinguish the goods and services of Opposer, and is thereby likely to cause dilution of Opposer's Mark.

If Applicant obtains such rights as conferred under the Principal Register of the Lanham Act, it will obtain at least a *prima facie* exclusive right to use its alleged trademark, and Opposer will be subjected to great and irreparable damage, and Applicant will enjoy unlawful gain and advantage to which it is not entitled under the Lanham Act.

WHEREFORE, MACRON S.P.A. believes and avers that it will be damaged by the registration of the Application, and respectfully requests that the Application be

rejected, that no registration be issued thereon to Applicant, and that the Opposition be sustained in favor of MACRON S.P.A.

Dated: Salt Lake City, Utah
July 6, 2015

KIRTON MCCONKIE

By: /Nicholas D. Wells/

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Attorney for Opposer
MACRON S.P.A.

CERTIFICATE OF SERVICE

I hereby certify that on the 6th day of July, 2015, I served a copy of this NOTICE OF OPPOSITION on Applicant's Attorney of record, as designated below, by placing said copies in the United States Mail, first class, postage prepaid, addressed as follows:

BRIAN KEMPNER
250 FERNDALE RD
SCARSDALE, NEW YORK 10583-1532

By: /Nicholas D. Wells/

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